

REMARKS/ARGUMENTS

Claims 1, 2, 4, 5, 9, 14, 15, 17 and 18 are pending. Claims 1, 2, 4, 5 and 9 stand rejected. Claims 6-8, 10-13, 16, 19 and 20 were previously cancelled without prejudice. Claim 3 is cancelled herein without prejudice. Claims 1, 9 and 14 are amended herein. No new matter has been added herein as a result of the amendments.

Applicants wish to thank the Examiner for the Examiner's interviews on January 25 and January 28 of 2010. In these interviews, we discussed the body of the Board of Appeals decision in the Office Action mailed December 31, 2009 (hereinafter, "instant Office Action") which affirms the reversal of the rejection of Claims 3, 14, 15, 17 and 18, while still rejecting independent Claims 1 and 9 and the pending dependents thereof (with the exception of Claim 3). We discussed the need to amend Claims 1, 9 and 14 to include the features of Claim 3 as well as further amending Claims 1 and 9 with language garnered from the specification regarding the features of Claim 3.

The rejections and comments set forth in the Office Action mailed December 31, 2009 (hereinafter, "instant Office Action") have been carefully considered by the Applicants. Applicants respectfully request the Examiner to consider and allow Claims 1, 2, 4, 5, 9, 14, 15, 17 and 18 in view of the instant response.

Claim Amendments

Claim 1 recites the following (Claim 9 includes similarly amended features):

An apparatus for identifying a requested level of service for a transaction, comprising:
computer readable storage media; and
computer readable program code stored in said storage media, comprising:
a) program code for prompting a user to select a requested level of service for said transaction; [[and]]
b) program code for assigning said requested level of service to said transaction;
c) program code for selecting a backup level of service; and
d) program code for assigning said backup level of service to said transaction when said requested level of service is unavailable, wherein said transaction is directed to a network device that is best able to provide said requested level of service for processing said transaction, wherein said best able to provide is determined by program code of a load balancer as to what is a nearest level of service to said requested level of service.

Support for these amendments may be found at least in Applicants' specification on page 4, lines 8-10 and 12-15, page 8, lines 20-21, page 12, lines 6-10, page 17, lines 29 and 30 and page 18, lines 1-5.

CLAIM REJECTIONSRejection under 35 U.S.C. §102(e)**Claims 1, 3-5 and 9**

In the Office Action mailed April 19, 2007, Claims 1, 3-5 and 9 were rejected under 35 U.S.C. §102(e) as being anticipated by Bearden et al. (U.S. Patent Application No. 6,871,233) (hereinafter, "Bearden"). The instant Office Action affirms the rejections of 1, 4, 5 and 9 and reverses the rejection of Claim 3. The rejections and comments set forth in the instant Office Action have been carefully considered by the Applicants. Applicants respectfully submit that Claims 1, 4, 5 and 9 are not anticipated by Bearden in view of at least the instant response.

Applicants respectfully point out that amended Claim 1 (Claim 9 includes similar features) recites:

An apparatus for identifying a requested level of service for a transaction, comprising:
computer readable storage media; and
computer readable program code stored in said storage media, comprising:
a) program code for prompting a user to select a requested level of service for said transaction; [[and]]
b) program code for assigning said requested level of service to said transaction;
c) program code for selecting a backup level of service; and
d) program code for assigning said backup level of service to said transaction when said requested level of service is unavailable, wherein said transaction is directed to a network device that is best able to provide said requested level of service for processing said transaction, wherein said best able to provide is determined by program code of a load balancer as to what is a nearest level of service to said requested level of service.

MPEP §2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”. MPEP §2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 103 (Fed. Cir. 1987). ... “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). “The elements must be arranged as required by the claim...” *In re Bond*, 910 F.2d 831, 15 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The instant Office Action states:

The limitation of ‘program code for selecting a backup level of service’ in claim 3 does not require allowing a user to select a backup level of service, but could refer to the program code selecting a backup or default level of service. Nevertheless, the Examiner has not pointed out how any program code ‘selects’ a backup level of service. Accordingly, the rejection of claim 3 is reversed.

(Emphasis added; instant Office Action, page 9, second paragraph.) Furthermore, Applicants respectfully submit that Bearden does not teach:

program code for assigning said backup level of service to said transaction when said requested level of service is unavailable, wherein said transaction is directed to a network device that is best able to provide said requested level of service for processing said transaction, wherein said best able to provide is determined by program code of a load balancer as to what is a nearest level of service to said requested level of service.

as is recited in Claim 1.

Thus, Applicants respectfully submit that Bearden does not anticipate the features as are set forth in independent Claim 1, and as such, Claim 1 traverses the rejection under 35 U.S.C. §102(e) and is in condition for allowance. Accordingly, Applicants also respectfully submit that Claim 9 is in condition for allowance for the reasons stated herein with regards to Claim 1.

Furthermore, Applicants respectfully assert that Claims 4 and 5 depending on Claim 1 are allowable as being dependent on an allowable base claim.

Claims 14, 15, 17 and 18

The Office Action mailed April 19, 2007 rejected Claims 14, 15, 17 and 18 under 35 U.S.C. §102(e) as being anticipated by Davies et al. (U.S. Patent Application No. 6,483,805) (hereinafter, “Davies”). The instant Office Action states:

Because Appellants have shown error in the Examiner’s finding that Davies teaches ‘d) program code for directing said transaction over said network based on said requested level of service read from said service tag,’ the anticipation rejection of claims 14, 15, 17 and 18 is reversed.

(Instant Office Action, page 14, first paragraph.)

Even though the rejection of Claims 14, 15, 17 and 18 was reversed in the instant Office Action, in response to the Examiner’s interviews held on January 25 and 27 of 2010, Applicants amend herein Claim 14 to include those features of Claim 3 (the rejection for which also having been reversed in the instant Office Action).

Applicants respectfully submit that Claim 14 is in condition for allowance. Furthermore, Applicants respectfully submit that Claims 15, 17 and 18 are in condition for allowance as being dependent on an allowable base claim.

Claim Rejections under 35 U.S.C. §103(a)**Claim 2**

The Office Action mailed April 19, 2007 rejected Claim 2 under 35 U.S.C. §103(a) as being unpatentable over Bearden in view of Davies. The instant Office Action affirmed this rejection. Applicants respectfully submit that Claim 2 is patentable over Bearden in view Davies for at least the following rationale.

“As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries” including “[a]scertaining the differences between the claimed invention and the prior art” (MPEP 2141(II)). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (emphasis in original; MPEP 2141.02(I)).

Applicants respectfully note that “[t]he prior art reference (or references when combined) need not teach or suggest all the claim limitations. However, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art” (emphasis added; MPEP 2141[III]).

As described herein, Applicants respectfully submit that Bearden fails to teach the features of Applicants’ Claim 1. Furthermore, Applicants respectfully submit that Davies fails to

remedy the insufficiencies of Bearden. Applicants understand Davies to teach “Internet differentiated services service for transaction applications” (instant Office Action, page 9, section 5). However, Applicants respectfully assert that Davies fails to teach or suggest the following features of Applicants’ Claim 1:

program code for assigning said backup level of service to said transaction when said requested level of service is unavailable, wherein said transaction is directed to a network device that is best able to provide said requested level of service for processing said transaction, wherein said best able to provide is determined by program code of a load balancer as to what is a nearest level of service to said requested level of service.

Moreover, Applicants respectfully assert that Davies fails to provide a motivation to modify Bearden to arrive at the features of Applicants’ Claim 1.

Thus, in view of the combination of Bearden and Davis not satisfying the requirements of a *prima facie* case of obviousness, Applicants respectfully assert that Claim 1 is patentable over Bearden in view of Davis and is in condition for allowance. Additionally, Applicants respectfully submit that Claim 2 depending on Claim 1 is in condition for allowance as being dependent on an allowable base claim.

CONCLUSION

In light of the above-listed remarks and amendments, the Applicants respectfully request allowance of the Claims 1, 2, 4, 5, 9, 14, 15, 17 and 18. Applicants again wish to thank the Examiner for his time in the Examiner interviews conducted on January 25 and 27, 2010.

The Examiner is urged to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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